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PATENT
Attorney Docket No. 041465-5064-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Takao SAWABE et al.)
)
Application No.: 10/058,098) Group Art Unit: 2655
)
Filed: January 29, 2002) Examiner: W. Young
)
For: APPARATUS FOR REPRODUCING)
INFORMATION FROM RECORD)
MEDIUM ON WHICH AUDIO)
INFORMATION OF DIFFERING)
RECORDING METHODS IS RECORDED)
(AS AMENDED))

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APR 08 2003

Commissioner for Patents
Washington, DC 20231

Technology Center 2600

Sir:

SUPPLEMENTAL RESPONSE

In response to the Office Communication dated March 7, 2003 (Paper No. 5), and further to the Amendment filed on December 16, 2002, the period for response to which extends through April 7, 2003, favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

Summary of the Office Communication

The Amendment filed on December 16, 2002 is allegedly not fully responsive because the Amendment does not particularly point out the patentable novelty of new claims 17-44. More specifically, the Communication asserts that new claims 18-26 do not include the apparatus limitation argued with respect to claim 9, claims 27-44 are drawn to methods, and claims 36-44 do not include a method limitation that can be construed as corresponding to the limitation argued with respect to claim 9.

New Claims 17-44

Applicants have added new claims 17-44 by the Amendment filed on December 16, 2002.

With regard to claim 17, the Examiner acknowledged in the Communication that since claim 17 depends from claim 9 Applicants may rely on dependency. Accordingly, Applicants respectfully submit that claim 17 is allowable at least because of its dependence from claim 9 and for at least the same reasons as independent claim 9.

With regard to claims 18-44, Applicants respectfully submit that *Endoh et al.* (U.S. Patent No. 6,016,295), the only applied reference in the Office Action dated July 16, 2002, teaches an audio system for converting an audio data by a decoder into surround audio signals, and no portion of *Endoh et al.*'s disclosure appears to discuss reproducing the audio information among a plurality of audio information which are different in recording method. See also page 12, lines 14-18 of the Amendment. Thus, Applicants respectfully submit that *Endoh et al.* also fails to teach or suggest at least the claimed combination recited in independent claim 18 including "the control information including identification information indicating that the plurality of information pieces are same in content and different in recording method with each other, said information reproducing apparatus for reproducing the information piece in accordance with the control information, comprising... a selecting device for selecting the recording method, the information piece in which is to be reproduced, on the basis of the identification information; and a reproducing device for reproducing the information piece which is selected by the selecting device."

Similarly, Applicants respectfully submit that *Endoh et al.* also fails to teach or suggest at least the claimed combination recited in independent claim 27 including "the control information

recorded on the control information recording area including identification information indicating that the plurality of audio information are same in content and different in recording method with each other, said information reproducing method for reproducing the audio information in accordance with the control information, comprising the steps of: ...selecting the recording method, the audio information in which is to be reproduced, on the basis of the designation information or set information stored in a memory device; and reproducing the audio information in the recording method, which is selected by the selecting step from among the plurality of audio information same in content and different in recording method, on the basis of the control information and the recorded information read by the step reading the record information.”

Moreover, Applicants respectfully submit that *Endoh et al.* fails to teach or suggest at least the claimed combination recited in independent claim 36 including “the control information including identification information indicating that the plurality of information pieces are same in content and different in recording method with each other, said information reproducing method for reproducing the information piece in accordance with the control information, comprising the steps of:... selecting the recording method, the information piece in which is to be reproduced, on the basis of the identification information; and reproducing the information piece which is selected in the step of selecting the recording method.”

M.P.E.P. §2131 states “[t]o anticipate a claim, the reference must teach every element of the claim.” Also, M.P.E.P. §2143.03 instructs that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” Since, in view of the above, *Endoh et al.* fails to teach or suggest each and every element set forth in independent claims 18, 27 and 36, it

is respectfully submitted that *Endoh et al.* does not render claims 18, 27 and 36 unpatentable. Since claims 19-26, 28-35 and 37-44 depend from claims 18, 27 and 36, respectively, it is respectfully submitted that *Endoh et al.* also does not render claims 19-26, 28-35 and 37-44 unpatentable. Accordingly, Applicants respectfully submit that claims 17-44 are allowable over the prior art of record.

Conclusion

Applicants note that detailed distinctions between claims 9-14 and the applied art were presented in the Amendment filed on December 16, 2002. Also, claims 15-16 were indicated as including allowable subject matter in the Office Action dated July 16, 2002. Accordingly, Applicants respectfully submit that all of pending claims 9-44 are in condition for allowance.

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Dated: April 7, 2003

Respectfully submitted,

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